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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,880	11/13/2003	Ming Ta Hsu	24061.50 (TSMC2002-1130)	2319
42717	7590	11/17/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			LEVINE, ADAM L	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 11/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,880

Applicant(s)

HSU ET AL.

Examiner

Adam Levine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9 March 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to because Figures 6,7 and 8, described in the Specification and listed in the Brief Description of the Drawings, are not present in the Application. As a result the drawings are also objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: All reference signs from 600 through 816. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claim 9 is objected to because of the following informalities: The third "the" in line 4 is extraneous and should be deleted. Appropriate correction is required.

Claim 26 is objected to because of the following informality: The limitation "the data entry device" is recited in line 5. There is insufficient antecedent basis for this limitation in the claim. Examiner believes that the applicant intended this to refer to the same element as the quotation entry device previously introduced in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 4 is rejected as being incomplete for omitting an essential element, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted element is: the respective mapping database record associated with the product.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Shavit (US Patent No. 4,799,156).

Shavit teaches all the limitations of Claims 1-31. For example, Shavit discloses an interactive electronic communication and processing system for business transactions between buyers and sellers, accessed using terminals, and storing information in databases (see at least Abstract, Figs. 1,2,13,14; column 2 lines 9-15, column 5 lines 39-65). Shavit further discloses:

- receiving a quotation including at least a first product and its quote amount:
quotation entry device, storing the quote amount, memory connected to the data entry device (see at least column 11 line 52 – column 12 line 18, column 16 line 50 - column 17 line 2, column 33 line 28 – column 34 line 2, column 40 lines 27 - 35); receiving the order that identifies at least the first product and desired quantity, an order entry device (see at least column 13 line 51 – column 14 line 9); quotation entry device and the order entry device comprise a single device (see at least Abstract, column 5 lines 16-65, column 13 line 51 – column 14 line 9. Please note: as described in Shavit, virtually every function performed can be performed by the same device); calculating an order price associated with the

first product by accessing the stored quote amount, and determining the order price based on the quote amount and the desired quantity, price calculator configured to receive order from order entry device, access memory, identify quote amount, and calculate price based on quantity and quote amount (see at least column 13 line 10 – column 14 line 9, column 25 lines 28 – 50).

- the product manufacturing facility is a semiconductor foundry: (Please note: The nature of the facility and its particular industry is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).
- quote amount is stored in a quotation database: connected to the order entry device (see at least column 12 line 54 – column 13 line 34, column 25 lines 28 – 50, column 29 line 31 – column 30 line 2, column 33 line 28 – column 34 line 2, column 36 lines 22 – 53, column 39 lines 1-4, column 40 lines 5-17).
- storing predetermined information associated with the first product in a product database: (see at least column 2 lines 9-15, column 7 lines 6-22, column 25 line 51 – column 26 line 4, column 40 lines 28-35); updating a mapping database with predetermined information from the quotation database and the product database associated with the first product (see at least column 24 line 53 – column 25 line 9, column 31 line 32 – column 32 line 9, column 36 lines 22-53,

column 40 lines 28-35); determining the order price based on the quote amount from the mapping database associated with the first product and the quantity identified in the product manufacturing facility order, mapping database is updated automatically when new quotation is entered into quotation database, when the product database is changed (see at least column 24 line 53 – column 25 line 9, column 31 line 32 – column 32 line 9, column 36 lines 22-53, column 40 lines 28-35. Please note: utilizing database triggers or auto-call functions is inherent in automatic database updating).

- receiving a quote amount for a second product: storing the quote amount (see at least column 11 line 52 – column 12 line 18, column 16 line 50 - column 17 line 2, column 33 line 28 – column 34 line 2, column 40 lines 27 - 35); calculating order price associated with the second product, wherein the received order identifies at least the first product and the second product and desired respective quantities, by accessing the stored quote amount associated with the second product, and determining the order price for the second product based on the stored quote amount associated with the second product and the desired quantity identified in the product manufacturing facility order, wherein the quote amount associated with the first product and the quote amount associated with the second product are in the same quotation (see at least column 12 line 54 – column 14 line 9, column 25 lines 28 – 50, column 29 line 31 – column 30 line 2, column 33 line 28 – column 34 line 2, column 36 lines 22 – 53, column 39 lines 1-4, column 40 lines 5-17).

Pertaining to method and computer readable medium Claims 1-18 and 19-25

Rejection of Claims 1-18 and 19-25 is based on the same rationale as noted above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit (US Patent No. 4,799,156) in view of Senior (US Pub. No. 2002/0029171).

Shavit teaches all of the above as noted under the 102(b) rejection and teaches a) using remote terminals for inputting quotes and orders, b) using a single device for performing multiple functions such as inputting both quotes and orders, c) using multiple locations for storing databases containing product information, orders and quotations, and further teaches accessing various databases, placing orders, and communicating quotations from remote locations via the internet. Shavit, however, does not disclose the single device being a personal data assistant, the quotation entry device connected to the memory via a wireless connection, or the order entry device connected to the price calculator via a wireless connection. Senior teaches the single device being a personal data assistant, the quotation entry device connected to the memory via a

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wireless connection, and the order entry device connected to the price calculator via a wireless connection (see at least page 4 para.0063). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Shavit to include the single device being a personal data assistant, the quotation entry device being connected to the memory via a wireless connection, and the order entry device being connected to the price calculator via a wireless connection as taught by Senior, in order to improve the convenience of using of the system, make the system more accessible, and make the system easier to use, thereby attracting more users to the system and increasing commerce using the system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references all describe systems, apparatuses and/or methods that include receiving quotations and orders of products, storing quotations, orders, and product information in databases, updating databases based on new information, calculating order totals based on quotations, products ordered, and quantity of each product ordered, and devices for communicating quotations and orders.

- Johnson, US Patent No. 6,023,683 (February 2000).
- Horn, US Pub. No. 2002/0156688 (October 2002).
- Kenney, US Patent No. 6,026,376 (February 2000).
- Peterson, US Patent No. 6,324,522 (November 2001).
- Fujinaga, US Pub. No. 2001/0056379 (December 2001).


- Morrison, US Pub. No. 2002/0042750 (April 2002).
- Mukai, US Pub. No. 2002/0077932 (June 2002).
- Tanaka, US Pub. No. 2002/0103751 (August 2002).
- Edwards, US Pub. No. 2002/0156695 (October 2002).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571.272.7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adam Levine
Patent Examiner
November 9, 2005


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